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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,608	08/15/2001	L. Michael Maritzen	80398.P428	1723

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EXAMINER

HOLZEN, STEPHEN A

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/930,608	Applicant(s) MARITZEN ET AL.	
	Examiner Stephen A. Holzen	Art Unit 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7,9-13 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7,9-13 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/27/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the rejection of claims 6, 13, and 24 have been fully considered and are persuasive. The applicant has argued that the rejection was improper because the reference and the current application are commonly owned. The rejection of the claims has been withdrawn.
2. Claims 2-7, 9-13, 20-24 are pending
3. Claims 2-7, 9-13, 20-24 have been rejected.
4. The examiner has re-evaluated his position with regards to the Carter reference and does not believe that a secondary reference is required in order to support prima facia case of obviousness.
5. In applicant's response received on 11/26/2004 applicant has argued that the examiner can not read limitations from the specification into a claim when the limitations are not recited in the claim. The examiner asserts that the claims are read in light of the specification and the scope of each claim should be judged with the specification in mind. If the specification provides a broad non-limiting example of a particular claim limitation, than it should be appreciated that the scope of this claim limitation is broad enough to encompass said non-limiting example.

6. Applicant argued on 1/25/2005 that Carter teaches using a credit card to complete a transaction. The examiner disagrees. Credits cards are use to initiate and authorize a financial transaction. They are not used to complete financial transactions.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-7, 9-13, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter (5,926,798) in view of ordinary skill in the art.

Re – Claims 6, 13, 24: Carter discloses a computer implemented method in which at least one intelligent agent negotiates the purchase of a product or service on behalf of a party (see Col. 2, lines 54+), the computer implemented method comprising:

configuring the at least one intelligent agent to determine whether one of the products and services offered by a supplier satisfies preferences established by the party (303),

dispatching the at least one intelligent agent from a client to a service (see Col. 2, lines 54+),

using the at least one intelligent agent to customize the price for one of the product and the service using one of the personal data associated with the part and at least one arbitrary pricing policy (see "Negotiate Deals" in Col. 2, lines 67)

authorizing, by a transaction device (credit card), the at least one intelligent agent to anonymously purchase (credit cards used over the internet are anonymous) one of the product and the service from the supplier, the transaction device providing the authorization through the VISA network (i.e. a transaction privacy clearing house (TPCH)) without revealing an identity of the party using the transaction device to the supplier. (The Visa and MasterCard organization are cooperative ventures owned by banks that issue their cards. In addition to the organization themselves, there are at least two banks involved in most credit-card transactions – the acquiring bank that handles the merchants credit-card account and the issuing bank that issued the card to the buyer. When the agent gives the authority to "run" the card, the merchant "runs" the credit card number and contact is made with the Visa/MC computers which further rout the call to the bank that issued the card, which then verifies that the buyer's account exists, and that the card being used has not been reported as stolen, and that the transaction would not put the customer over his or her credit card limit. Note: there is no identification of what person is using the card; there is no exchange of personal information tying the user of the card to the owner of the account. Indeed children use their parent's credit cards all the time, especially for on-line purchases. Credit Cards and their networks are anonymous.) Carter uses a

credit card to authorize a credit card clearinghouse network (such as VISA) to authorize the financial transactions between the buyer and the seller.

The only aspect of the present invention that Carter does not disclose is the using historical purchase activity of the party, a potential future purchase activity of the party, or a group to which the party is a member to negotiate price.

However using personal data to negotiate a purchasing price is well known in the art to be useful in obtaining price reductions. (Sam's Club is one example of the above claimed subject matter). It would have been obvious to reward the purchaser with better prices based on group memberships and potential future purchase activity, to build a relationship between customer and sellers.

Re – Claim 3, 10, 21: Carter discloses that intelligent agents register the buyers with the supplier without the buyer's active involvement. (see Col. 9, lines 9-11: steps 306-308).

Re – Claim 4, 11, 22: Carter discloses that intelligent agents perform data mining operations (Col. 5, lines 31-33).

Re – Claim 5, 12, 23: Credit card clearing house networks are secure links between customer, suppliers and financial institutions that are based upon at least one preference established by the party (i.e. VISA, MC or DISCOVER network).

Re – Claim 7: The intelligent agent compares prices of one supplier with those of a second supplier.

9. Claims 2, 9, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter as applied to claims 6, 13, and 24 above, and further in view of ordinary skill in the art. Carter does not disclose using the size of a purchase as a negotiating chip or incentive to obtain a lower per unit sales price. However, it is well known in the art that purchasing a product or service in bulk provides the buyer a stronger negotiation position resulting in lower prices. Sam's Club is again an example of this interaction. Buyers are required to buy their purchases in large bulk, however they are rewarded for their continual patronage (i.e. membership) and bulk purchases with lower per product prices. It would have been obvious to use bulk purchasing as a price negotiating position in order to save money.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases "determining" and "using" render the claim indefinite since they are statements of intended use. The statements of intended use are essentially language that suggests or makes optional but does not require steps to be performed or does not limit the scope of a claim or claim limitation (MPEP § 2106(II,C)). Accordingly, the metes and bounds of the claim cannot be ascertained by one having ordinary skill in the art.

12. Claims 9-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner cannot determine the scope of the "means for" language in these claims. What apparatus and structure is meant by and encompassed by the "means for" language. The examiner believes that any computer circuit anticipates or at least renders obvious these "means". If applicant believes that the examiner is improperly viewing the "means for" limitations, the applicant should outline the scope of each of these limitations so that a reader of ordinary skill in the art would recognize what all is meant by and encompassed by the "means for" phrases.

13. Claims 24-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Claims 20-24 are "apparatus" claims. The only apparatus limitation is an "executable program instruction". The phrases:

- a. Configuring
- b. Determining
- c. Use
- d. Dispatching
- e. Using
- f. Purchasing
- g. Authorizing

render the claim indefinite since the examiner can not determine whether or not these method steps limit the apparatus. The phrases listed above (8a-g) render the claim indefinite since they are statements of intended use. The statements of intended use are essentially language that suggests or makes optional but does not require steps to be performed or does not limit the scope of a claim or claim limitation (MPEP § 2106(II,C)). Accordingly, the metes and bounds of the claim can not be ascertained by one having ordinary skill in the art.

Notes to Applicant

14. The examiner has not afforded applicant the weight of 112 6th paragraph for claims 9-13. The examiner can not determine what all is meant and encompassed by the "means for" language.

- h. "means for using"

- i. "means for purchasing"
- j. "means for authorizing"
- k. "means for reducing"
- l. "means for registering"
- m. "means for performing"
- n. "means for customizing"

The examiner believes that a hard drive anticipates or at least renders obvious each of the "means for" language, as is presently used by the applicant. If applicant believes that the examiner is improperly viewing the "means for" limitations, the applicant should outline the scope of each of these limitations so that a reader of ordinary skill in the art would recognize what all is meant by and encompassed by the "means for" phrases.

15. The examiner asserts that the limitations of independent claim 24 do not limit the scope of the apparatus being claimed. The applicant has only used method limitations and method steps to define what the invention does, and not what the invention is. An apparatus claim must be defined by what the invention is and not by what the invention does. In a broadest sense the claims are only limited to the capability to perform these limitations. A Computer Program and Intelligent Agent are inherently capable of performing these steps.

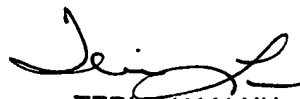
Art Unit: 3644

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen A. Holzen whose telephone number is 571-272-6903. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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